

REMARKS

By this Amendment, Applicants have canceled claims 1-89, 91, and 110-201 without prejudice or disclaimer. Claims 90, 92, 93, 95, 96, 105, 108, and 202-204 have been amended to further define the invention. New claim 206 has been added and is directed to the subject matter of canceled claim 201. No new matter has been added. Claims 90, 92-109, and 202-206 are pending in this application.

Applicants note that the Examiner indicated that claim 158 was improperly listed in two groups of the restriction requirement and that claim 158 should have been grouped with one of the non-elected groups of claims. Applicants disagree with this further restriction of claims and assert that claim 158 was properly elected and should be examined on its merits. However, in an effort to promote prosecution, Applicants have canceled claim 158 without prejudice or disclaimer.

Applicants acknowledge the indication of allowable subject matter in dependent claim 201. Claims 195-201 have been canceled and new independent claim 206 has been presented. New claim 206 is directed to the subject matter of claim 201. Claims 202-204 have been amended as necessary to depend from new claim 206. Applicants submit that claims 202-204 and 206 are now in condition for allowance.

Reconsideration is requested.

In the outstanding Office Action, claims 93 and 108 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that the apparatus set forth in claims 14-16, 33, 34, 131, and 132 is not sufficiently associated with the function or step recited in the claims. Applicants presume that the Examiner meant claims 93 and 108 as claims 14-16, 33,

34, 131, and 132 were withdrawn from consideration. Applicants disagree with this characterization of the claims. Each of the functions or manipulative steps set forth in the aforementioned claims inherently recites its relationship to the claimed folding operation. These relationships are further clarified in the specification. However, solely in an effort to further prosecution and place this application in condition for allowance, Applicants have amended claims 93 and 108 to further define the structure used to perform the function. Applicants assert that claims 93 and 108 are now in condition for allowance. Reconsideration is requested

Claims 90-109, 195-200, and 202-204 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the patent to Morantz, U.S. Patent No. 5,555,572 in view of the patent to Newell, U.S. Patent No. 5,546,730. The Examiner asserted that Morantz shows a packaging apparatus comprising a conveyor 20 that moves a load in direction P (Figure 11a), four cornerboard magazines (Figure 2), means (148) for gripping a cornerboard from each magazine, means for driving the gripping means parallel to direction P (64/66 - Figures 4 & 11b to 11c), means for moving the gripping means transverse to direction P (140 - Figures 4 & 11b to 11c), means for rotating the gripping means, and means (144 - Figures 4 & 11b) for wrapping the load and the cornerboard. The Examiner acknowledged that Morantz lacks means for folding an unformed cornerboard.

The Examiner asserted that Newell shows a packaging device that uses cornerboards in either an unformed or prefolded state (column 5, line 50 et seq.). The Examiner also asserted that the machine comprises a gripper 72 for moving the cornerboards to the load with pivotable portions (see column 8, lines 11 et seq., and

Figures 9-11) to fold a cornerboard into its final position. The Examiner concluded that it would have been obvious to one skilled in the art to use unformed cornerboards in the Morantz operation and fold them as taught by Newell so that the cornerboard can be easily handled and shipped in flat condition. Applicants respectfully disagree.

Amended claim 90 requires, in part, “removing a cornerboard from within the magazine with a gripper, folding the cornerboard with the gripper,” and “transporting the cornerboard to a corner of the load with the gripper subsequent to folding the cornerboard.” Amended claim 105 requires in part “transporting the folded cornerboard with the gripper in a direction parallel to a longitudinal axis of the load transport surface until a first leg of the cornerboard is proximate a first side of a corner of the load,” and “transporting the folded cornerboard with the gripper in a direction transverse to the longitudinal axis of the load transport surface until a second leg of the cornerboard is proximate a second side of the corner of the load.” Original claim 205 requires “moving a gripper and an unformed cornerboard out of a magazine for storing unformed cornerboards, folding the unformed cornerboard,” and “transporting folded cornerboard to a corner of the load with the gripper.”

As acknowledged by the Examiner, Morantz does not disclose or suggest use of flat or unformed cornerboards. Newell does disclose folding unformed cornerboards. However, Newell discloses using a cornerboard picker 50 to remove cornerboards 120 from loading station 40 and delivering the unformed cornerboard to a cornerboard placer 70. See col. 6, line 62-col. 7, line 68, and Figs. 3-7. Cornerboard placer 70 includes a pair of finger members 72 to fold the cornerboard 120 and cornerboard

placer 70 is also configured to deliver the cornerboard 120 to the load. See col. 8, line 1 to col. 9, line 43.

Amended claim 90 and original claim 205 each require that the corner board be removed from the magazine and transported to the load with the same gripper. Newell does not disclose or suggest this. Instead, Newell discloses using separate structures to remove the cornerboard from the magazine and to transport the cornerboard to the load. Thus, even if one were to combine the structures of Morantz and Newell as suggested by the Examiner, the respective inventions of claims 90 and 205 would not result. Reconsideration is requested.

With regard to amended claim 105, neither Morantz nor Newell discloses or suggests folding an unformed cornerboard with a gripper and then “transporting the folded cornerboard with the gripper in a direction parallel to a longitudinal axis of the load transport surface until a first leg of the cornerboard is proximate a first side of a corner of the load,” and “transporting the folded cornerboard with the gripper in a direction transverse to the longitudinal axis of the load transport surface until a second leg of the cornerboard is proximate a second side of the corner of the load.”

Morantz does not disclose or suggest moving in a first direction until a first leg of the cornerboard is proximate to the first side of a corner of the load, or subsequently moving in a second direction until a second leg of the cornerboard is proximate to the second side of the corner of the load. As illustrated in Figs. 4-7 and 11C-D, and discussed in column 9, lines 19-29, the pick-up plates of Morantz only move a preset distance based on the stroke of cylinder 140. The pick-up plates first move a pre-set distance longitudinally inwardly relative to the load as illustrated by the arrows in Fig.

11C, and stop moving while still distanced or spaced away from the load. They then move a pre-set distance parallel to a longitudinal axis of the conveyor, toward the load, as illustrated by the arrows in Fig. 11D, and again stop moving.

If Morantz is to be modified as suggested by the Examiner to incorporate the cornerboard placer 70 of Newell, then it would be necessary to import the cornerboard placer controls of Newell to control the cornerboard placer 70 of Newell. Newell teaches that cornerboard placer 70 moves toward the load "in a direction oblique to the respective sides of the load while maintaining the first and second side portions [of the cornerboard] generally parallel with the respective sides of the load to simultaneously place the first and second portions proximate the respective sides of the load." See col. 3, lines 8-16. Specifically, the gripper is moved in both the "x" direction and the "y" direction several times until positioned, rather than moving in one direction until reaching the load and subsequently moving in the second direction until reaching the load. See col. 11, lines 1-38 and Figs. 11A-11D. Thus, if one were to modify Morantz with the gripper and controls of Newell, the present invention as claimed would not result. Reconsideration is requested.

For at least these reasons, Applicants assert that independent claims 90, 105, 205, and 206 and the claims that depend respectively therefrom are allowable over Morantz and Newell. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each also are separately patentable. Reconsideration is requested.

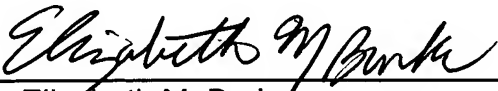
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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